

REMARKS

This Amendment After Final is being timely filed.

Applicants submit the amendments herein address issues that are first raised in the outstanding Office Action, and were not made earlier, because the first indication to Applicants that the present amendments would be needed was in the current Office Action (see paragraph 4 of the Office Action). Also, it is respectfully requested that the present Amendment be entered into the Official File in view of the fact that the Amendment automatically places the application in condition for allowance. Thus, the present Amendment is believed to be in proper form for placing the application in condition for allowance.

In the alternative, if the Examiner continues with the rejections of the present application, it is respectfully requested that the present Amendment be entered for purposes of an Appeal. The Amendment reduces the issues on appeal by overcoming at least the rejections under 35 U.S.C. § 102. Thus, the issues on appeal would be reduced.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendment to the claims and the following remarks.

Status of the Claims

In the present Amendment, claim 2 has been amended. No new matter has been added as this amendment has support at least at page 48, lines 7-11 of the present specification (wherein the foaming technique(s) are not included in the present invention). Applicants further note that in *In re Wertheim*, the court stated: "Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of

what they invented and originally claimed is patentable". 191 USPQ (BNA) 90, 97 (CCPA 1976). Further, this amendment addresses the Examiner's comments in the Office Action (explained in more detail below).

Claims 2, 3, 8 and 22-28 are pending in the present application.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the remaining rejections and allow the currently pending claims. Rejections not stated in the outstanding Office Action are withdrawn (see page 2, paragraph 3 of the Office Action).

Issues Under 35 U.S.C. § 102(b) and § 103(a)

Claims 2, 3, 8 and 22-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 103(a) over JP '656 (JP 11-254656; computer translation) as set forth in paragraph 5 of the October 25, 2005 Office Action and paragraph 4 of the current Office Action. Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

The "solid" adhesive layer of the present invention occasionally includes fine foam formed in the step of forming this layer. But this means that the present adhesive layer is still considered solid and thus is structurally different from the foam layer of the JP '656 embodiment. Thus, there is a difference in having "fine foam" present in the claimed "solid" adhesive layer of the present invention versus the actual foam/foamed layer in the JP '656 embodiment.

However, as stated in paragraph 4 of the Office Action, the Examiner is maintaining the present rejection by referring to specific parts of the JP '656 reference and the previously filed

Rule 132 Declaration. Thus, the Examiner stresses the following three general points:

- (i) Applicants should clarify the scope of difference, e.g., how the foaming process results in a structure in JP '656 which would be excluded by pending claim 2 (not claim 1 as stated in Office Action) of the instant invention (see page 2, line 5 to page 4, line 2 of paragraph 4 of the outstanding Office Action), wherein the previously filed Rule 132 Declaration shows how a "solid" adhesive layer stills reads upon the JP '656 reference (page 3, lines 14-19 of the Office Action);
- (ii) The Rule 132 Declaration clearly shows that JP '656 is capable of absorbing ink solvent (see page 4, lines 3-13 of the Office Action); and
- (iii) Applicants' arguments are not commensurate in scope with the Rule 132 Declaration (see page 4, line 14 to page 5, line 2 of the Office Action).

First, regarding how (i) Applicants should clarify the difference between claim 2 and the JP '656 structure (made by a foaming process), Applicants respectfully refer the Examiner to claim 2 as presented herein. Claim 2 does not include such a foaming process as discussed in the JP '656 disclosure. Specically, the presently claimed pressure-sensitive adhesive layer is not the same as the foamed layer of JP '656 because the foaming process in JP '656 needs an expansion step after or during the step of applying and drying, while the instantly claimed solid adhesive layer does not. This expansion step leads to structural differences. Specifically, the expansion step makes a structure with holes that characterizes the foamed layer of JP '656, and the instantly claimed solid layer does not have such holes. Also, pending claim 2 recites the "solid" adhesive layer, which means that the present invention can include "fine foam" in said solid adhesive layer wherein this fine foam is not the same as the holes generated by the said

expansion step. Thus, the present invention is patentably and structurally distinct from the JP '656 foamed embodiment.

Regarding the method of manufacturing in JP '656, Applicants respectfully refer the Examiner to the previously filed English language translation of the JP '656 reference (as provided by Applicants), wherein paragraph [0012] discloses:

The cleaning sheet of the present invention can be manufactured by using a conventional foaming forming method, for example, an extrusion foaming forming method and an ejection foaming forming method or the like. After a mixed solution containing the resin constituting the foam layer 3 and a suitable foaming agent is applied on the base material 2, the cleaning sheet can be also manufactured by heating and foaming the mixed solution. A foaming method can be suitably selected according to the kind of the resin, any method such as a method (mechanical foaming method) for forming the resin by mechanical stirring, a method for using reaction generation gas, a method for using a foaming agent (a volatile foaming agent or a degradable foaming agent), a method for removing a soluble substance, a method for foaming by a spray, a method for forming a syntactic foam, and a sintering method may be used.

Thus, JP '656 describes that it is necessary to force a resin composition layer to form foam by using a conventional foaming forming method when manufacturing the foaming layer of JP '656. Further, as discussed above, JP '656 uses an expansion step to form holes that characterizes the foamed layer. Further, the present specification explains that "the removing sheet having the foam layer on a substrate can be prepared by conventional foaming techniques such as extrusion foaming and injection foaming" (see page 48, lines 7-10). On the other hand, the present invention utilizes an adhesive layer wherein this forced foaming forming method is not used.

Thus, Applicants respectfully maintain that there is a difference in having "fine foam" as present in the claimed "solid" adhesive layer of the present invention (e.g., see pending claim 2 herein) versus the foam/foamed layer in the JP '656 embodiment. It is thus believed that the

Examiner's inquiry of (i) Applicants clarifying the difference between pending claim 2 and the foaming process resulting in the JP '656 structure has been sufficiently addressed.

Applicants also maintain there is no disclosure of the claimed features of, e.g., "wherein the pressure-sensitive adhesive sheet after absorbing 5g/m^2 of the solvent has a tackiness of 3 cN/25-mm or more as determined by a method in conformity with Japanese Industrial Standards (JIS) Z 0237" as recited in pending claim 5. What this means is that when the pressure-sensitive adhesive sheet is peeled off from an article that is treated, the solidified matter after absorption of the solvent is stuck to the pressure-sensitive adhesive sheet and is thus removed from the article. In this regard, Applicants respectfully refer the Examiner to page 32, lines 11-21 of the present specification for the discussion of this advantageous property of the present invention. Applicants further note that the structural distinctions pointed out above lead to this solvent absorption (not adsorption) property. In addition, it appears that the recent Office Action has not addressed this point as previously asserted by Applicants. Thus, Applicants respectfully request consideration of this claimed feature as rebutting/overcoming the instant rejections.

Therefore, based on the above, the present invention is structurally, patentably distinct from the embodiment of the JP '656 reference. Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited JP '656 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of JP '656 is overcome. Reconsideration and withdrawal of this rejection under § 102(b) are respectfully requested.

With regard to the rejection under § 103(a), a *prima facie* case of obviousness has not been established since there is no disclosure of all claimed features as explained above. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Withdrawal of this rejection is also requested.

The following comments are with respect to at least pending claim 3.

Regarding the assertions that (ii) the Rule 132 Declaration shows that JP '656 is capable of absorbing ink solvent and (iii) Applicants' arguments are not commensurate in scope with the Rule 132 Declaration, Applicants respectfully traverse based on the following. Though the Examiner mentions that the solvent absorption of Example B of Declaration, which represents JP '656, is higher than Example A (the present invention), Applicants respectfully maintain that the efficiency of removal of a solvent-containing substance of the present invention is superior to that of JP '656. Essentially, not all values in the Declaration are being analyzed and the photographs attached to the Declaration are also relevant.

First, the state of the art is such that a layer having the higher solvent absorption cannot always efficiently remove the solvent-containing substance. Second, the present invention solves such a problem in the art. Specifically, the instantly claimed pressure-sensitive adhesive sheet still has tackiness (3 cN/25-mm or more) even after absorbing a predetermined amount of the solvent. This means that the present invention is highly efficiency at cleaning even after such solvent absorption. Such effects of the claimed invention are also supported by the photographs that were attached to the same Rule 132 Declaration.

Further, the Declaration clearly shows that solvent absorption of Example A is higher than that of Example B. Regarding the adhesiveness after absorbing the predetermined amount

of 5 g/m² of the solvent, the value of Example A (0.11 N/25-mm; (see page 3, starting at line 1 of the Declaration) is superior to the 0.07 N/25-mm value of Example B. Accordingly, Example A corresponds to the pressure-sensitive adhesive sheet of the present invention and establishes how the present invention has retained sufficient adhesiveness as well as exhibiting effective removal properties of a stain observed in the stainless steel plate. In this regard, please again refer to the photographs attached to the Rule 132 Declaration (the inferior staining by Example B is shown as “No. 3” and highlighted in the photos). Also, Applicants also take this opportunity to remind the Examiner of the movie demonstration that was shown at a previous Interview between the Examiner and Applicants’ representative. That movie also showed the advantageous absorption and tackiness properties of the present invention. Thus, Applicants have established unexpected results for the present invention that are commensurate in scope with what is claimed. As stated in M.P.E.P. § 2144.09 (see section entitled “*Prima Facie* Case Rebuttable By Evidence of Superior or Unexpected Results”), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention. For example, Applicants respectfully refer to the solvent absorption/tackiness features of the disputed independent claims. Therefore, reconsideration and withdrawal of the § 103(a) rejection are respectfully requested.

Overall, Applicants respectfully submit that JP ‘656 fails to disclose all claimed features and that these rejections have been overcome. Reconsideration and withdrawal thereof are respectfully requested.

Conclusion

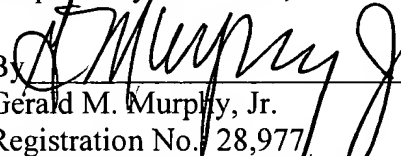
A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 8, 2006

Respectfully submitted,

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